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January 14, 2002

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

Re:	Application Serial No.:	09/193,647
	Applicants:	Usner, et al.
	Title:	Apparatus and Method for Indicating the Status of Transaction Function Devices in an Automated Banking Machine
	Docket No.:	D-1077+11

Sir:

Please find enclosed the Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate for filing in the above-referenced application.

It is believed that no extension of time is required. However, if such an extension is required then please consider this a petition therefore.

Please charge the fee required with this filing ($320) and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of   )
        Usner, et al.   )
)   Art Unit 2161
Serial No.:   **09/193,647**   )
)
Filed: **November 17, 1998**)   Patent Examiner
)   Pierre Eddy Elisca
Title: **Apparatus and Method for**)
          Indicating the Status of   )
          Transaction Function Devices)
          in an Automated Banking Machine)

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.192

Sir:

    The Appellants hereby submit their Brief pursuant to 37 C.F.R. § 1.192, in triplicate,

concerning the above-referenced Application.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is

Diebold, Incorporated, an Ohio corporation.

RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this

matter.

STATUS OF CLAIMS

Claims 1-19 are pending in the Application.

Claims 1-5, 7-8, and 11-13 were rejected pursuant to 35 U.S.C. § 102(a) as anticipated by

a Dialog file referring to an article in Bank Network News titled "Internet Technology Pushes

New Services To ATMs" dated April 11, 1997 (hereinafter "BankNet").

Claims 6, 9, and 14-15 were rejected pursuant to 35 U.S.C. § 103(a) as being

unpatentable over BankNet.

Claims 16-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vak, et

al. (US 5.473,143) (hereinafter "Vak").

Claim 10 has not been objected to or rejected. It follows that for purposes of this appeal

the status of claim 10 is considered as allowed.

These rejections were the only rejections present in the Office Action ("Action") dated August 14, 2001, which was made Final. Appellants appeal the rejections of the claims, inclusive.

STATUS OF AMENDMENTS

A final rejection was made August 14, 2001. An amendment was filed on November 13, 2001 rewriting claim 10 into independent form.

The amendment was denied entry in the Advisory Action dated December 13, 2001 for the sole reason that "The newly added limitations in claim 10 require further search." However, the Advisory Action does not explain what the alleged "newly added limitations" constitute.

Appellants respectfully submit that claim 10 in the amendment after final rejection is the same as finally rejected dependent claim 10, but merely rewritten into independent form. That is, there are no "newly added limitations" as the Office alleges. The Office's unfair refusal to enter the amendment after final rejection is merely reflective of the impropriety of all the rejections from which this appeal has been taken, as shown in more detail hereinafter. Appellants respectfully submit that the amendment after final rejection should be entered and claim 10 should be viewed as an allowed independent claim.

As the Office has not provided on the record a valid reason for denying entry of the amendment of November 13, 2001, Appellants request the Board to view the amendment of November 13, 2001 as entered and claim 10 as an allowed independent claim.

SUMMARY OF INVENTION

Overview of the Invention

Exemplary embodiments of the present invention are directed to an apparatus including an ATM (12). The ATM includes a computer (34) in operative connection with a plurality of transaction function devices (36), such as a note dispensing device (42). The computer can cause the note dispensing device to dispense cash from the ATM. The computer may generate an HTTP record which includes indicia therein that is representative of the status of one or more of the transaction function devices in the ATM. The status indicia may be representative of a fault or malfunction which has occurred in a transaction function device. The ATM also includes at least one communications connection. The computer in the ATM functions as a server which enables the HTTP record to be accessed by another computer external of the ATM through the communications connection.

The HTTP records such as HTML documents which include status indicia, may be accessed locally or remotely. A technician using a hand-held computer which includes a browser or other software operative to access the HTTP records, may access the documents through the ATM server locally while the technician is at the ATM for purposes of maintenance, diagnosis, and servicing. Alternatively, the status of ATM devices may be monitored by computers at remote locations anywhere that is connected in a network with the ATM. For example, an HTTP record including indicia indicative of a need to replenish currency may be directed by the server in the ATM to a network address associated with an entity who has responsibility for replenishing currency in the ATM.

4

The HTTP records which indicate the status of the transaction function devices may have different forms depending on the software configuration and the needs of the system operator. In some embodiments the device status information for one or more devices may be represented by indicia contained within a data object. The data object may be transferred to other connected computers to provide the status data.

The transferring of a data object may be used to conduct testing or modification of transaction function devices in the ATM. For example, indicia included in the data object may be modified in a computer operated by a servicer and the modified object passed back to the ATM. The software in the machine may cause the transaction function devices to operate or change conditions or programming in response to the modified data object. For example, this may include clearing a fault indication or causing a device to operate to clear a jam or to conduct a test of the ATM.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

1). Whether Appellants' claims 1-5, 7-8, and 11-13 are unpatentable under 35 U.S.C. § 102(a) as being anticipated by BankNet.

2). Whether Appellants' claims 6, 9, and 14-15 are unpatentable under 35 U.S.C. § 103(a) over BankNet.

3). Whether Appellants' claims 16-19 are unpatentable under 35 U.S.C. § 103(a) over Vak.

GROUPING OF CLAIMS

No groups of claims stand or fall together. Each of Appellants' claims recite at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

The pending claims include six independent claims (claims 1, 7, 12, 16, 18, and 19). Claims 2-6 depend from claim 1. Claims 8-9 and 11 depend from claim 7. Claims 13-15 depend from claim 12. Claim 17 depends from claim 16. As previously discussed, claim 10 should be viewed as an allowed independent claim. All pending claims are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).*

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish prima facie obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of

obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

If the Office does not produce a *prima facie* case, then the Appellant is under no obligation to submit evidence of nonobviousness (MPEP § 2142).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The BankNet Article

The BankNet article is a Dialog article directed to Canadian Imperial Bank of Commerce proposing to test an ATM "concept" using Internet-type technology (page 1, third paragraph). The testing is to determine if the bank can do targeted marketing and advertising. For example, offering specialized services such as ordering and picking up theater and airline tickets, providing weather or stock information, or offering merchant promotions that vary with the individual.

The ATMs envisioned in the BankNet article remain connected in an intranet, yet use Internet-type technology. The BankNet article uses an intranet (as opposed to using the Internet) "to ensure privacy and avoid delays" (page 1, second to last paragraph) and for reasons of security and quick transactions (page 2, paragraph 7). The intranet uses "dedicated telephone lines" (page 1, second to last paragraph). Use of an intranet ensures that ATM transactions will not be "delayed by Internet traffic jams" (page 2, paragraph 7).

The Vak Reference

Vak is directed to an electronic mail system that uses ATM or POS (point of sale) network terminals. A message service control function differentiates the messages from the financial transactions normally exchanged over the network. A user is able to receive and transmit messages to other users.

Figure 1 shows a terminal (22, 24; 26, 28; 34) and a processor (18; 36) connected to a clearing house data network (42) and clearing house network processor (44). An ATM data network (16) and POS data network (38) are also shown. In the electronic mail system (10) messages can be stored or retrieved through an ATM or POS terminal.

During operation a user inserts a debit or credit card (48) into a terminal. The terminal, in conjunction with a local microprocessor, acquires the user's identity and security information. After the user enters a PIN, the terminal communicates through its own data network (16; 38), institution processor (18; 36), and clearing house network (42) with the clearing house network processor (44). The clearing house network processor (44) then interacts with the user's financial institution processor (46) to access the user's account, to obtain user authorization for electronic mail access, and to acquire user fee information. After receiving user access authorization for the electronic mail system (10), the clearing house network processor (44) then activates its message service control function to access, via the clearing house network (42), stored messages for the user that may be stored on a store and forward message switch (52). Via the clearing house network (42) the switch (52) then sends the stored messages back to the user terminal. The user

9

may also respond to or originate messages for storage on the store and forward message switch (52) using the terminal in the same manner as in requesting access to stored messages.

(iii)   35 U.S.C. § 102

Appellants' remarks in the amendment filed May 21, 2001 are herein incorporated by reference as if fully rewritten herein.

Appellants' remarks concerning the claim rejections in no way waive their rights to have the rejections relying on the BankNet article stricken for the reasons presented herein.

The U.S. BankNet Article Does Not Constitute Prior Art

The Recited Invention Has An Earlier Date Than The BankNet Article

The BankNet article allegedly has a date of April 11, 1997. The present application is entitled to the benefit of U.S. provisional application 60/031,956 filed November 27, 1996. This provisional application discloses in detail all of the features and relationships which are alleged to be "inherent" in the BankNet Article.

For example, the provisional application discloses an automated banking machine with at least one transaction function device, a server in operative connection with the transaction function device, and at least one HTML document accessible through the server (e.g., claim 1). This provisional application further discloses an HTML document including instructions or indicia which correspond to a condition or status of a transaction function device. In an example,

the provisional application discloses an automated banking machine (12), transaction function devices (36), and a server (88, 90, 92). Examples of provisional application disclosure relating to a transaction function device status maybe found at page 13, lines 9-15; page 14, line 19 to page 15, line 9; page 35, line 7 to page 36, line 8. Also note provisional application page 5, lines 9-20, and page 12, lines 9-15.

As all of these features are clearly disclosed in the provisional application filed on November 27, 1996, the BankNet article does not constitute prior art with regard to Appellants' claims. The rejections relying on the BankNet article are therefore improper. Thus, Appellants respectfully submit that the rejections should be withdrawn.

The BankNet article does not constitute a prior art printed publication

Appellants traverse the allegation that the BankNet article is a legitimate prior art document. Appellants question the accuracy of the date (April 11, 1997) and subject matter of the apparently electronically-produced document. Appellants have not been provided evidence of the validity of this document. Appellants have not received a non-electronic copy version of this allegedly April 11, 1997 published BankNet article.

The Office has presented no proof that this electronic document version of the BankNet article was accessible to members of the public on April 11, 1997 or prior to Appellants' filing date. Appellants challenge the alleged creation (and/or alleged publically accessible) date of the electronic document as a prior art date. Nor has the Office shown that the information relied upon in the electronic document version was identical to an earlier-published (prior art) non-

electronic copy version. Therefore, the relied upon BankNet article does not constitute a prior art printed publication. Appellants also respectfully request that the rejections be withdrawn on this basis.

In conclusion the Office's reliance on the BankNet article is moot because the article does not constitute prior art. Thus, Appellants respectfully submit that all rejections relying on the BankNet article should be withdrawn.

The Pending Claims Are Not Anticipated By BankNet

In the Action claims 1-5, 7-8, and 11-13 were rejected under 35 U.S.C. § 102(a) as being anticipated by the BankNet article. These rejections are respectfully traversed.

As noted above, the BankNet article does not constitute prior art. Appellants particularly invite comparison of the discussion at page 35, line 7 through page 36, line 8 of the earlier provisional application to the BankNet article. Nevertheless, even if it were somehow possible for the BankNet article to constitute prior art, it still would not teach all the features and relationships of the invention arranged in the manner recited in the claims. BankNet lacks many of the recited features and relationships. The features recited in Appellants' claims patentably distinguish over the BankNet article.

Appellants' arguments against the rejections are based on the Office's interpretation of the BankNet article as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the article by the Office would constitute a new grounds of rejection.

12

Appellants' arguments show that the applied BankNet article does not teach each and every feature or step of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Therefore, the BankNet article cannot anticipate the claims.

The rejections rely on alleged inherency in the BankNet article. Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).* MPEP § 2112.

Appellants respectfully submit that the Action does not establish inherency involving the BankNet article. Thus, Appellants respectfully submit that the 35 U.S.C. § 102(a) rejections should be withdrawn.

Claim 1

Claim 1 is an independent claim directed to an apparatus. BankNet does not disclose at least the features:

- at least one HTML document accessible through a server.

- at least one document that includes indicia corresponding to a status of the transaction function device.

13

The Action alleges that BankNet inherently discloses a transaction function device, a server, and an HTML document. The Appellants disagree.

Appellants respectfully submit that the Office has not provided objective evidence or cogent technical reasoning to support any conclusion of inherency. For example, where does the recited feature of an HTML document necessarily flow from the teachings of the BankNet article? All the article mentions is that there is a future "concept" for a system using "Internet-type technology". No mention is made as to how this concept system would work. No mention is made of using HTTP records such as HTML documents to indicate ATM information. Even the Action admits (at page 5, lines 6 and 14) that Web pages are "typically" defined using HTML. That is, even if it were somehow possible for the concept discussed in the BankNet article to use Web pages, the Action admits that they are not limited ("necessarily present") in such a system. Thus, the BankNet article cannot anticipate the claim.

Additionally, where does the feature of a document having indicia corresponding to a status of a transaction function device in an ATM necessarily flow from the teachings of the BankNet article? The BankNet article is not concerned with the status of any transaction function device. The BankNet article does not even hint at using an HTML document in (corresponding) relation to the status of a transaction function device. Nor does the BankNet article disclose producing an HTML document which includes indicia which represents status data concerning a transaction function device. Further, even if it were possible for the ATMs in the BankNet article to have used the indicated intranet dedicated line to communicate, any status information communicated would not have necessarily involved including status information in

14

an HTML document or HTTP record in the manner recited. The "concept" system may not have

been capable of transmitting status data, or alternatively status data may have been transmitted on

the dedicated line using conventional messages that were not sent via TCP/IP.

As the BankNet article does not teach anything about ATM status technology, nor has any

other evidence relating to inherency been presented, then the article cannot be construed to

provide any teaching regarding transaction function device status technology for ATMs. Further,

there is nothing in the BankNet article that requires that an HTML document including indicia

corresponding to a status of a transaction function device in the manner recited be necessarily

present in the described "concept" system. Thus, the BankNet article cannot anticipate the claim.

The Action (on pages 4 and 5) states that "in order for tickets to be printed out at ATM, a

server and HTML document is inherently required." The Appellants disagree. The ATMs in the

BankNet article are in an intranet, not the Internet. The BankNet article uses an intranet (as

opposed to using the Internet) "to ensure privacy and avoid delays" (page 1, second to last

paragraph) and for reasons of security and quick transactions (page 2, paragraph 7). The intranet

uses "dedicated telephone lines" (page 1, second to last paragraph). Use of an intranet ensures

that ATM transactions will not be "delayed by Internet traffic jams" (page 2, paragraph 7). As

the BankNet article uses an intranet over which standard or non-standard messages may be

communicated, there is no evidence that a server or an HTML document is needed. Furthermore,

the alleged requirement of a server and an HTML document as being necessary for printing

tickets is incorrect. ATMs produced by Diebold, Incorporated (the assignee of the present

invention) produced at least as early as the mid-1980s were programmed to print tickets as one of

15

the available transactions. This was certainly accomplished without use of HTML documents. See for example the printing of tickets discussed in U.S. Patent No. 5,240,368 filed in 1989, column 1, lines 1-17.

The Action (on pages 4 and 5) further states that a server and HTML document is inherently required "in order to interact via the Internet at the ATM." The Appellants disagree. The BankNet article does not have "the Internet at the ATM" as alleged. The BankNet article has an intranet at the ATM. Again, neither a server nor an HTML document is required.

Also, any allegation of inherency relating to the BankNet article must pertain to the date of the article. The date of the Action (and apparently the technological reasoning of the Office) is years removed from the alleged BankNet article date. The Office cannot allege inherency in the BankNet article when that inherency is based on newer technology.

Furthermore, it should be reemphasized that there is absolutely no disclosure in the BankNet article as to an apparatus capable of accomplishing the desired result. Indeed the article itself expressly indicates that what is described is purely a "concept." There is no indication in the BankNet article that the parties whose activities were being reported on knew how to achieve such a system. Clearly there is no teaching in the BankNet article to one skilled in the art as to what the parties discussed in the article were planning to do in terms of an actual system or how they would go about making or operating such a system. Thus, the BankNet article makes clear that the system described therein was a "concept" that did not even exist, and therefore such undisclosed features cannot be "necessarily present" as is required to sustain an inherency rejection.

There is no disclosure in the BankNet article of the features specifically recited in the claim. For example, there is no disclosure of a server in operative connection with a transaction function device, an HTML document accessible through the server, or a document including indicia corresponding to a status of a transaction function device as recited.

It is respectfully submitted that the pending claim 1 and all claims that depend therefrom should be allowed because the BankNet article does not constitute prior art. The BankNet article also does not disclose each and every element of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Thus, the claim should further be allowed because the BankNet article does not teach all of the recited features and relationships either literally or inherently. Hence, Appellants' claim patentably distinguishes over the BankNet article. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(a) rejection should be withdrawn.

Claim 2

The Action asserts that the BankNet article at page 2, paragraph 1 teaches the recited features. The Appellants disagree. The cited paragraph relates to printing tickets which were already ordered through the bank's Web site. The BankNet article does not teach that the printer (apparently the alleged transaction function device) is operative to print the tickets "responsive to" an HTTP message received by the server. Instead, the tickets likely would be printed in response to one or more authorization messages (non-HTTP messages) in the manner of the prior art ATMs. Thus, the BankNet article cannot anticipate the claim. Further the features recited in

claim 2 are fully supported by the November 27, 1996 provisional application which is prior to the alleged date of the BankNet article.

Claim 3

The Action asserts that the BankNet article at page 2, paragraph 1 teaches the recited features. The Appellants disagree. The cited paragraph does not relate to (nor does the BankNet article teach) a status representative of a fault which has occurred in a transaction function device. It follows that the BankNet article does not teach a document having indicia corresponding to a fault status of a transaction function device in the manner recited. Thus, the BankNet article cannot anticipate the claim for this reason, as well as for the reason that the BankNet article is not prior art.

Claim 4

The Action relies on the BankNet article at page 2, paragraphs 1 and 9 to teach the recited features. The Appellants disagree. The cited paragraph does not relate to plural transaction function devices nor HTML document indicia corresponding to a status of each of the plurality of transaction function devices. It follows that the BankNet article does not teach the recited features and relationships.

Furthermore, even if it were somehow possible for the BankNet article to disclose a plurality of transaction function devices as alleged, there would still be no teaching of HTML document including indicia corresponding to a status of each of the plurality of transaction function devices in the manner recited. Thus, the BankNet article cannot anticipate the claim. Nor is the BankNet article prior art.

Claim 5

The BankNet article does not disclose an ATM in the manner recited. Nor does the BankNet article anticipate the claim. Nor is the BankNet article prior art.

Claim 7

Claim 7 is an independent claim directed to a method. Appellants' remarks concerning the BankNet article discussed above in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. The BankNet article is not prior art. The BankNet article also does not disclose (at least) the features:

- generating at least one first HTML document including first instructions corresponding to the status of the transaction function device.

The BankNet article provides no teaching of generating an HTML document that includes instructions corresponding to the status of a transaction function device of an ATM. There is no teaching that the BankNet article generates any HTML document or is concerned with the status of any transaction function device. Nor is there any teaching in the BankNet article of an HTML document indicating the status of a transaction function device. It follows that the BankNet article does not teach generating an HTML document (including instructions) corresponding to the status of a transaction function device. The BankNet article does not teach all of the recited features and relationships either literally or inherently. Thus, the BankNet article cannot anticipate the claim.

Claim 8

Claim 8 depends from claim 7. The Action relies on the BankNet article at page 2, paragraph 1 to teach the recited features. The Appellants disagree. The cited paragraph does not relate to (nor does the BankNet article teach) accessing a document with a terminal including a browser. The BankNet article is silent concerning a browser or a terminal including a browser. Thus, the BankNet article cannot anticipate the claim. No is the BankNet article prior art.

Claim 11

Claim 11 depends from claim 7. The Action asserts that the BankNet article at page 2, paragraphs 1 and 9 teaches the recited features. The Appellants disagree. The cited paragraphs do not relate to (nor does the BankNet article teach) receiving an HTML document including instructions, and operating a transaction function device in the ATM responsive to the instructions. As previously discussed, the Action incorrectly interprets the BankNet article as an Internet-based ATM. However, as previously discussed, the BankNet article clearly discusses a system that is intranet-based to provide security and avoid Internet traffic jams (page 2, paragraph 7). Furthermore, even if it were somehow possible for the BankNet article to be an Internet-based web ATM, there would still be no teaching of receiving HTML documents with instructions, and operating the transaction function device responsive to those instructions. Thus, the BankNet article cannot anticipate the claim. Further the BankNet article does not constitute prior art because of the earlier filing date of the provisional application disclosing the recited features from which priority is claimed.

Claim 12

Claim 12 is an independent claim directed to an apparatus. Appellants' remarks

concerning the BankNet article discussed above in support of the patentability of claims 1 and 7

are incorporated by reference as if fully rewritten herein. The BankNet article is not prior art.

The BankNet article also does not disclose (at least) the features:

- machine software operative to cause a transaction machine computer to generate

    an HTTP record including indicia representative of the status of a transaction

    function device.

- the software includes a server, wherein the generated HTTP record is accessible

    through the server.

The BankNet article provides no teaching of generating an HTTP record that includes

indicia representative of the status of a transaction function device in an automated transaction

machine. Nor is there any teaching that the BankNet article uses a transaction machine computer

to generate an HTTP record. Nor is there any teaching that the BankNet article is concerned with

or is capable of indicating the status of a transaction function device. Nor is there any teaching in

the BankNet article of linking an HTTP record to the status of a transaction function device. Nor

does the BankNet article teach a server, or that a generated HTTP record is accessible through the

server.

The BankNet article does not teach all of the recited features and relationships either

literally or inherently. Thus, the BankNet article cannot anticipate the claim. The recited

21

features are all found in the earlier provisional application the priority of which has been claimed, and therefore the BankNet article does not constitute prior art.

Claim 13

Claim 13 depends from claim 12. The Action relies on the BankNet article at page 2, paragraph 1 to teach the recited features. The Appellants disagree. The cited paragraph does not relate to (nor does the BankNet article teach) an HTTP record comprising an HTML document.

The BankNet article provides no teaching of generating an HTTP record that comprises an HTML document. As previously discussed, the BankNet article provides no teaching of generating an HTML document that includes indicia representative of the status of a transaction function device of an automated transaction machine. There is no teaching that the BankNet article generates any HTTP record or is concerned with the status of any transaction function device. Nor is there any teaching in the BankNet article of linking an HTTP record (and HTML document) to the status of a transaction function device. It follows that the BankNet article does not generate an HTML document (including indicia) representative of the status of a transaction function device. Thus, the BankNet article cannot anticipate the claim. Nor is the BankNet article prior art.

(iv)   35 U.S.C. § 103

Again, Appellants' arguments against the prior art rejections are based on the Office's interpretation of the references as indicated and applied in the Action. Therefore, it is

respectfully submitted that any other interpretation of the references by the Office would constitute a new ground of rejection.

The attempts to modify each of the primary references are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged. Furthermore, without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01).

The applied references, neither disclose nor suggest the recited features and relationships. Nor would it have been obvious to one having ordinary skill in the art to have modified the references to have produced the recited invention. The Office does not factually support any *prima facie* conclusion of obviousness. If the Office does not produce a *prima facie* case, which is the current situation, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

The Pending Claims Are Not Obvious Over
<u>BankNet</u>

Claims 6, 9, and 14-15 were rejected under 35 U.S.C. § 103(a) as obvious over the

BankNet article. These rejections are respectfully traversed. As previously discussed the

BankNet article does not constitute prior art.

<u>Claim 6</u>

Claim 6 depends from claim 1 and is allowable for the same reason. Claim 6 further

recites a portable terminal including a browser. Claim 6 further recites that the terminal

including the browser is operative to access the HTML documents which include indicia

corresponding to status of a transaction function device. Nothing in any cited prior art discloses

or suggests this, or provides any motivation for producing the combination of features recited in

Appellants' claim.

The Action alleges "official notice" that a portable computer (in association with the

automated transaction machine of claim 1) is well known, and for this reason it would be obvious

to produce the invention recited in claim 6. Appellants respectfully traverse the alleged official

notice. MPEP § 2144.03. Appellants also respectfully wish to point out that there is absolutely

no teaching, suggestion, or motivation in any cited prior art reference for using a portable

terminal including a browser to access an HTML document including indicia corresponding to

the status of a transaction function device in an automated transaction machine. Thus, the Office

has not presented a *prima facie* showing of obviousness.

Appellants respectfully traverse the official notice assertion on the basis that it is not supported by any reference to prior art. The Office is not permitted to rely merely on assertions of "official notice" as the basis for rejecting claims. Furthermore, when challenged the Office is required to establish such assertions in the proper manner through citation to prior art as required by MPEP § 2143.03 and 2144.03. Appellants previously challenged the "official notice." The challenge has not been properly rebutted by the Office. Thus, in view of the Action's absence of an express showing of the asserted teachings in the prior art, the rejection is improper and should be withdrawn.

Furthermore, the Action's failure to properly provide citation to prior art in support of the alleged "official notice" constitutes Agency Action under the Administrative Procedures Act admitting the absence of the asserted teachings. For these reasons it is additionally respectfully submitted that the Action fails to establish a *prima facie* case of obviousness against the claim and the rejection should be withdrawn.

Claim 9

Claim 9 depends from claim 8 and further recites that in the method of claim 8, the accessing step includes accessing the first document with a portable terminal adjacent to the automated transaction machine. By reference to claim 8 and claim 7 from which claim 9 depends, the first document that is accessed includes at least one HTML document that includes instructions corresponding to the status of a transaction function device. Nothing in the cited references discloses or suggests producing such a document associated with an automated

transaction machine, nor accessing such a document with a portable terminal adjacent to the automated transaction machine.

Again the Action allegedly takes "official notice." Appellants traverse the "official notice" and require the Office to prove the existence of the recited features in the prior art. Further, the "official notice" refers to accessing through the Internet using a portable computer. However, the claim does not specifically or only recite such features.

Appellants previously challenged the "official notice." The challenge has not been properly rebutted by the Office. Thus, in view of the Action's absence of an express showing of the asserted teachings in the prior art, the rejection is improper and should be withdrawn.

Furthermore, the Action's failure to properly provide citation to prior art in support of the alleged "official notice" constitutes Agency Action under the Administrative Procedures Act admitting the absence of the asserted teachings. For these reasons it is additionally respectfully submitted that the Action fails to establish a *prima facie* case of obviousness against the claim and the rejection should be withdrawn.

Additionally, the "official notice" refers to accessing through the Internet using a "portable computer." However, why would it have been obvious to access an ATM using a portable computer adjacent to the ATM? That is, why would one having ordinary skill in the art use a portable computer for ATM access when they are already adjacent (and can use) the ATM? It would not have been obvious to one having ordinary skill in the art to travel with their portable computer to an ATM, and then access the ATM through their portable computer, as the Action alleges. The Action's reasoning is defective.

26

The Office does not factually support any *prima facie* conclusion of obviousness. If the

Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit

evidence of nonobviousness (MPEP § 2142). Appellants respectfully submit that such is the

current situation. Therefore, the rejection is improper and should be withdrawn.

Claim 14

Claim 14 depends from claim 12 and further recites that the HTTP record, which includes

indicia representative of the status of a transaction function device, comprises a data object. The

Action asserts (without reference to any prior art whatsoever) that it would be obvious to have

the HTTP record comprise a data object. This rejection is legally deficient as the Office has not

shown that the features recited in the claim are known in the prior art, nor has there been any

citation to any prior art showing teaching, suggestion, or motivation to produce the claimed

invention.

Furthermore, the Action admits (referencing page 8, paragraph 3 of the Office Action

dated March 14, 2001) that the BankNet article "does not explicitly teach that the HTTP record

comprises a data object." As previously discussed, there is no teaching that the BankNet article

generates any HTTP record nor is even concerned with the status of any transaction function

device (claim 12). Nor is there any teaching in the BankNet article of linking an HTTP record to

the status of a transaction function device. Nor has the Action explained how the BankNet

article could be modified to include such an HTTP record with a data object. Thus, the Office

has not presented a *prima facie* showing of obviousness.

27

Claim 15

Claim 15 depends from claim 14 and further recites a terminal computer outside the automated transaction machine, and a communications connection operatively connecting the outside terminal computer with a transaction machine computer. Claim 15 further recites terminal software operative to transfer the data object from the automated transaction machine to the outside terminal computer.

The Action admits that recited features are not disclosed or suggested in the BankNet article. However, the Action alleges, without any support or citation to prior art, that such features are inherently disclosed. As previously discussed, such an allegation of inherency is improper absent a showing based upon prior art that the reference "necessarily presents" such features. Further, the Action alleges that object oriented programming is old and well known. There is no support for this contention, nor is there any citation to any prior art of the features claimed by Appellants nor any teaching, suggestion, or motivation in the prior art so as to produce Appellants' claimed invention.

The Pending Claims Are Not Obvious Over
Vak

Claims 16-19 were rejected under 35 U.S.C. § 103(a) as obvious over Vak. These rejections are respectfully traversed.

The rejections rely on "official notice" that using HTTP is well known in the communication art, and for this reason it would be obvious to modify the ATM of Vak with

HTTP to view a specific Web page in the Internet. Appellants respectfully traverse the alleged "official notice." MPEP § 2144.03. Appellants also respectfully wish to point out that there is absolutely no teaching, suggestion, or motivation in any cited prior art reference for using an HTTP record representative of a transaction function device in an automated transaction machine.

Appellants respectfully traverse the "official notice" assertion on the basis that it is not supported by any reference to prior art. Any "official notice" must pertain to information prior to Appellants' effective filing date (1996). The Action has provided no evidence of such prior art. As previously discussed, the Office is not permitted to rely on unsupported assertions of "official notice" as the basis for rejecting claims. Thus, the Office has not presented a *prima facie* showing of obviousness.

While Appellants discuss the Vak reference herein, such discussion will in no way constitute an admission or agreement that Vak in any way provides an enabling disclosure or that Vak otherwise constitutes a valid patent.

Claim 16

Claim 16 is an independent claim. Vak does not disclose or suggest:

- at least one automated transaction machine computer operative, responsive to the occurrence of a malfunction of a transaction function device, to include indicia in an HTTP record representative of the malfunction.

- a communications connection in operative connection with a machine computer, wherein the HTTP record is accessible by a computer external of the machine through the communications connection.

Vak does not disclose or suggest having a computer in an ATM that is operative, responsive to the occurrence of a malfunction of a transaction function device, to include indicia in an HTTP record representative of the malfunction. Nor does Vak disclose or suggest a communications connection to the computer which enables an HTTP record, which includes the indicia representative of the malfunction, to be externally accessed.

Vak is directed to an electronic mail system in which a user can use an ATM terminal to conduct transactions and send and receive electronic mail text messages. Vak is not concerned with sending or receiving electronic mail relating to a transaction function device malfunction. Why would a user of Vak's electronic mail system, who is charged fees for usage of the system, be concerned with sending (if possible) mail on behalf of a bank's malfunctioned ATM device? Nor does Vak have any need of an HTTP record representative of a transaction function device malfunction. Even the Action admits that "Vak does not specifically discloses a HTTP record representative of the malfunction."

Furthermore, there is no disclosure or suggestion in Vak that the electronic mail system is associated with the Internet, as the Action alleges. Contrarily, Vak appears limited to the dedicated lines of ATM and POS systems using EFT networks and a dedicated system for sending text messages. Vak also requires a card to access a terminal in order to use the electronic

30

mail system. Again, Vak would have no need or desire for an HTTP record, or for including indicia representative of a malfunction of a device in such an HTTP record.

The Action references Vak at col. 9, line 1 to col. 10, line 22. Vak's status panel (156), which is part of a terminal's input/output console (130), has indicators to inform a terminal user of the status of a transaction being performed and an indication if the transaction could not be conducted. This appears to be a reference to conventional prior art ATM outputs that advise a user of information such as that the ATM is out of service, that the user's transaction is being processed or that the user's transaction could not be processed. ATMs have been programmed for many years to output such messages to users. In fact some early ATM type machines output such messages to users by having them printed on a rotating drum that rotated to a particular angular position to display the appropriate message to the user depending on the condition of the ATM and/or the user's transaction.

The fact that prior ATMs output such messages from the ATM to a user discloses or suggests nothing concerning the recited HTTP messages which include indicia indicative of ATM device malfunctions. Further nothing in such prior art discloses or suggests communicating such HTTP messages to a computer external to the ATM. As such features are specifically recited in claim 16, and are not disclosed or suggested in Vak or any other prior art, it is respectfully submitted that claim 16 (and claim 17 that depends therefrom) is allowable.

It is further respectfully submitted that the Action's attempts to modify Vak are clearly hindsight reconstruction of Appellants' claimed invention, which is legally impermissible. The Office has not presented a *prima facie* showing of obviousness.

31

Claim 17

Claim 17 depends from claim 16 and is allowable for the same reasons. Additionally,

Vak does not disclose or suggest an ATM in the manner recited. Hence, the Office has not

presented a *prima facie* showing of obviousness.

Claim 18

Claim 18 is an independent claim. Appellants' remarks concerning Vak discussed above

in support of the patentability of claim 16 is incorporated by reference as if fully rewritten herein.

Vak does not disclose or suggest:

- responsive to a malfunction of a transaction function device, including indicia in
  at least one HTTP record representative of the malfunction.

- accessing the HTTP record with an external computer through a communications
  connection to the machine.

As previously discussed, Vak does not disclose (as admitted by the Action) or suggest an

HTTP record representative of the occurrence of a malfunction of a transaction function device in

an ATM, nor would it have been obvious to have modified Vak therewith. Nor does Vak

disclose or suggest accessing the HTTP record with an external computer.

Even if it were somehow possible for Vak to have the admittedly absent HTTP record,

where does Vak specifically teach or suggest to access the HTTP record with an external

computer? Again, the attempts to modify Vak are clearly hindsight reconstruction of Appellants'

claimed invention. It follows that it would not have been obvious to one having ordinary skill in

the art to have modified Vak to have produced the recited invention. The Office does not

factually support any *prima facie* conclusion of obviousness.

Claim 19

Claim 19 is an independent claim. Appellants' remarks concerning Vak discussed above

in support of the patentability of claims 16 and 18 are incorporated by reference as if fully

rewritten herein. Vak does not disclose or suggest:

- a server in operative connection with the plurality of transaction function devices
  of an automated transaction machine.

- an HTTP record including indicia representative of an operational status of at least
  one of the plurality of transaction function devices.

- a communications connection, in operative connection with the server, which is
  adapted to communicate the HTTP record to a computer outside the machine.

As previously discussed, Vak does not disclose (as admitted by the Action) or suggest an

HTTP record representative of the occurrence of a malfunction of a transaction function device,

nor would it have been obvious to have modified Vak therewith. Nor does Vak disclose or

suggest the ability to communicate the HTTP record to an external computer.

Vak also does not teach or suggest the recited server. It follows that Vak does not

disclose or suggest a communications connection in operative connection with a server, which is

also in operative connection with the plurality of transaction function devices. That is, Vak does

not disclose or suggest the relationship of a server with plural transaction function devices and a

33

communications connection. Nor has the Action provided any prior art teaching, suggestion, or motivation for modifying Vak in the manner recited.

Again, the attempts to modify Vak are merely hindsight reconstruction of Appellants' claimed invention. It follows that it would not have been obvious to one having ordinary skill in the art to have modified Vak to have produced the recited invention. The Office does not factually support any *prima facie* conclusion of obviousness. For these reasons it is respectfully submitted that claim 19 is allowable.

CONCLUSION

Each of Applicants' claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellants' invention. Claim 10 was not subject to any rejection and should currently stand allowed. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

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APPENDIX

CLAIMS

1.   Apparatus comprising:

an automated transaction machine including at least one transaction function

device, a server in operative connection with the transaction function device, at

least one HTML document accessible through the server, wherein at least one first

document includes indicia corresponding to a status of the transaction function

device.

2.   The apparatus according to claim 1 wherein the transaction function device is operative

responsive to an HTTP message received by the server.

3.   The apparatus according to claim 1 wherein the status is representative of a fault which

has occurred in the transaction function device.

4.   The apparatus according to claim 1 wherein the machine includes a plurality of

transaction function devices, and wherein the HTML document accessible through the server

include indicia corresponding to a status of each of a plurality of transaction function devices.

1

5. The apparatus according to claim 1 wherein the machine is an ATM.

6. The apparatus according to claim 1 and further comprising a portable terminal, wherein the portable terminal includes a browser, wherein the terminal is operative to access documents through the server.

7. A method comprising:

> operating a transaction function device in an automated transaction machine, the transaction function device having an associated status; and

> generating at least one first HTML document including first instructions corresponding to the status of the transaction function device.

8. The method according to claim 7 and further comprising the step of accessing the first document with a terminal including a browser.

9. The method according to claim 8 wherein the accessing step includes accessing the first document with a portable terminal adjacent to the automated transaction machine.

10. The method according to claim 8 wherein the accessing step includes accessing the first document through a network with a terminal located remotely from the automated transaction machine.

11. The method according to claim 7 and further comprising the steps of:

receiving a second HTML document with the machine, the second document including second instructions; and

operating the transaction function device responsive to the second instructions.

12. Apparatus comprising:

an automated transaction machine including a plurality of transaction function devices, wherein each of the transaction function devices has an associated status, wherein the status is indicative of an operative condition of the transaction function device;

a transaction machine computer in operative connection with the transaction function devices, and further comprising machine software executable in the computer, wherein the software is operative to cause the computer to generate at

3

least one HTTP record including indicia representative of the status of at least one transaction function device, and wherein the software further includes a server, wherein the first HTTP record is accessible through the server.

13.   The apparatus according to claim 12 wherein the HTTP record comprises an HTML document.

14.   The apparatus according to claim 12 wherein the HTTP record comprises a data object.

15.   The apparatus according to claim 14 and further comprising a terminal computer outside the automated transaction machine, a communications connection operatively connecting the transaction machine computer and the terminal computer, and further comprising terminal software in the terminal computer, wherein the terminal software and the machine software are operative to transfer the data object from the transaction machine to the terminal computer.

16.   Apparatus comprising:

        An automated transaction machine including:

a plurality of transaction function devices, wherein at least one note

dispensing device is included among the plurality of transaction function

devices,

at least one computer operative in the machine, wherein the at least one

computer is in operative connection with the plurality of transaction

function devices, and wherein the at least one computer is operative to

cause the at least one note dispensing device to dispense at least one note

from the machine,

wherein the at least one computer is operative responsive to the occurrence

of a malfunction of one of the transaction function devices to include

indicia in at least one HTTP record representative of the malfunction,

a communications connection in operative connection with the at least one

computer in the machine, wherein the at least one HTTP record is

accessible by a computer external of the machine through the

communications connection.

17.   The apparatus according to claim 16 wherein the automated transaction machine

comprises at ATM.

18.   A method comprising:

operating a plurality of transaction function devices in an automated transaction machine, wherein the machine is operative to dispense at least one note;

responsive to a malfunction of at least one of the transaction function devices, including indicia in at least one HTTP record representative of the malfunction;

accessing the HTTP record with an external computer through a communications connection to the machine.

19.   Apparatus comprising:

An automated transaction machine including:

a plurality of transaction function devices,

a server in operative connection with the plurality of transaction function devices,

at least one HTTP record including indicia representative of an operational

status of at least one of the plurality of transaction function devices,

a communications connection in operative connection with the server,

wherein the communications connection is adapted to communicate the at

least one HTTP record to a computer outside the machine.